REMARKS

Claims 1-36 remain pending in the application, with claims 1 and 30 being the independent claims. Reconsideration and further examination are respectfully requested.

In the Office Action, claims 1-36 stand rejected under 35 USC § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the office action states:

> nowhere in [the referenced] section of the specification does it discuss that a plurality of indentations is predominantly uncoated while a plurality of lower-extending portions are coated. Furthermore, this section fails to teach "a plurality of small particles bonded differentially to different areas of the bottom surface, with each of a plurality of the lower extending portions being coated more than each of the plurality of indentations." This area of the specification is silent as to the comparison between the coating of the indentations to the coating of the protrusions.

In response, Applicant initially notes that there was a slight error in the stated support for the subject claim limitations. In the previous Response, it was stated that Figure 4 and page 12 line 24 through page 13 line 2 of the Specification provided the required support. While the reference to Figure 4 is correct, the reference to the written description should have been "page 12 line 24 through page 13 line 12". Applicant apologizes for this error.

This portion of the Specification notes, e.g.:

> . . . by dipping the outsole 44 into a thin layer of adhesive, generally only such lowest extending parts 54 will be coated with adhesive and, therefore, ultimately coated with flocking material 18. [Emphasis added]

This language, and particularly the use of the word "generally" recognizes, e.g., that in actual manufacturing processes it is difficult, impossible or simply undesirable to precisely control the areas that are coated with flocking fibers or other small particles. These same considerations are reflected in the subject claim language, i.e., ". . . each of the plurality of indentations is

predominantly uncoated . . . " and, ". . . small particles bonded differentially to different areas of the bottom surface, with each of a plurality of the lower extending portions being coated more than each of the plurality of indentations."

When page 12 line 24 through page 13 line 12 of the Specification is read in conjunction with Figure 4, it is apparent that the application, as filed, clearly shows both such claim limitations. Accordingly, the subject limitations are believed to have the required support.

It is noted that there is no requirement that the Specification provide word-for-word support for claim limitations, as long as the specification supports such limitations either inherently or implicitly. See, e.g., MPEP § 2163, subsection I.B, which also provides:

> The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117.

The above-referenced portions of the Specification clearly show that Applicant was in possession of the presently claimed limitations.

Finally, and probably most importantly, MPEP § 2163.07(a) provides:

> By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. In re Reynolds, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); In re Smythe, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973).

In the present case, the bottom surface of the shoe illustrated in Figure 4, when processed in accordance with the techniques disclosed at page 12 line 24 through page 13 line 12 of the Specification, inherently would have the properties of the subject claim limitations.

Accordingly, the previous amendment of the claims to include such limitations is believed to be entirely proper.

For all of the foregoing reasons, withdrawal of the present rejection under § 112, first paragraph, is respectfully requested.

Claims 1-3, 5, 11, 12, 19, 20 and 24-36 stand rejected under 35 USC § 103(a) over U.S. Patent 4,356,643 (Kester) in view of U.S. Patent 4,658,514 (Shin); claim 4 stands rejected under § 103(a) over Kester in view of Shin and U.S. Patent 6,782,642 (Knoche); claim 6 stands rejected under § 103(a) over Kester in view of Shin and U.S. Patent 2,663,097 (Giese); claims 7, 8 and 10 stand rejected under § 103(a) over Kester in view of Shin and certain information of which the Office Action takes Official Notice; claim 9 stands rejected under § 103(a) over Kester in view of Shin and U.S. patent 4,779,360 (Bible); and claims 13-18 stand rejected under § 103(a) over Kester in view of Shin and U.S. Patent 5,276,981 (Schaffer). Withdrawal of these rejections is respectfully requested for the following reasons.

The present invention concerns a shoe having a plurality of indentations on its bottom surface, with lower extending portions between the indentations, and having a plurality of small particles bonded differentially to different areas of the bottom surface, with at least some of the lower extending portions being coated more than the indentations. A technique for achieving this configuration is described, e.g., at page 12 line 24 through page 13 line 12 of the Specification, with reference to Figure 4 thereof. In one representative embodiment, at least some of the lower extending portions have a plurality of small particles bonded to them, but each of the plurality of indentations is predominantly uncoated with such small particles. *Id.* In another, only the lower extending portions of the shoe's bottom surface are coated. See, e.g., page 12 lines 20-23.

One advantage of this configuration is that if and when the flocking or other particles eventually wear away, the entire bottom surface of the shoe often will have a more uniform appearance than if the entire bottom surface of the shoe were coated. The reason is that it ordinarily would be very difficult or impossible for the particles adhering to the surface within the indentations to wear away at the same rate as the particles on the lower extending portions. See, e.g., page 13 lines 6-12 and 25-28.

Thus, independent claim 1 is directed to a shoe in which the bottom surface, which is adjacent to the ground in normal use, has a plurality of indentations, with lower extending portions between such indentations. An example is set forth in Figure 4, which shows the cross-section of a portion of a shoe's insole and outsole, having indentations 52 and lower extending portions 54 between them. See, e.g., page 12 line 24 through page 13 line 12. A sole forms at least a portion of the bottom surface, and an upper portion extends above the sole. A plurality of small particles is bonded to at least some of the lower extending portions (e.g., portions 54), but each of the plurality of indentations (e.g., indentations 52) is predominantly uncoated with such small particles.

The foregoing combination of features is not disclosed or suggested by the applied art. In particular, no permissible combination of Kester and Shin would have disclosed or suggested at least the feature of: a plurality of indentations and lower extending portions between them, with a plurality of small particles bonded to at least some of the lower extending portions, but with each of the plurality of indentations (e.g., indentations 52) being predominantly uncoated with such small particles.

In this regard, the Office Action takes the position that the recited lower extending portions read on Kester's projections 14 and that the recited indentations read on the space

between such projections 14. At the same time, the Office Action acknowledges that Kester does not disclose that each of the lower extending portions is predominately uncoated with small particles.

In order to make up for this deficiency, the Office Action cites Shin as showing that the sole of a shoe can have protrusions 76 and indentations (i.e., Shin's slots 50), with the protrusions having ridges 78. The Office Action notes that Shin provides such ridges 78 to maximize traction. However, while that does appear to be one purpose of ridges 78, Shin in fact appears to indicate that the ridges 78 mainly are provided to create a cushioning effect. See, e.g., column 4 lines 2-6 of Shin. Thus, for example, column 4 lines 7-10 of Shin notes that similar bars 80 provided at the heel and toe sections 40 and 42 of Shin's outsole do not include ridges 78, as those areas of the shoe's sole are provided with a cushioned midsole.

In view of this observation, the Office Action's statement that "Shin '514 shows these indentations [presumably, slots 50] without any traction elements because this section does not touch the ground and the traction elements would prevent complete bending of the sole in these areas," does not necessarily follow. In fact, Shin provides no reason whatsoever as to why its slots 50 do not include the ridges 78.

The Office Action itself mentions two possible reasons (i.e., because traction is not necessary and because including such ridges would inhibit bending of the sole). Another potential reason is that because the slots 50 are significantly narrower than the major bar treads 76, there simply might not have been room within them to include a sufficient number of ridges to provide any desired effect. Any number of other possible design reasons (functional and/or aesthetic) might have been behind the reason not to include ridges 78 in slots 50, or there might have been no serious thought at all with respect to the decision.

As a result, it cannot be said that Shin taught any motivation "to remove the traction elements 16,17, 18 form the sole of Kester et al. '643, or not place these traction elements, in the area of the indentations to allow the sole to completely flex," as asserted in the Office Action. That is, with no clear teaching in either Kester or Shin regarding the design considerations in determining whether or not to use Shin's ridges 78, one of ordinary skill in the art would not have equated them with Kester's fibers and would not have learned anything about how to place such fibers based on a reading of Shin.

In fact, even the argument set forth in the Office Action appears to show at most that fibers might not have been necessary within Kester's indentations. However, Shin clearly does not teach that the additional effort to differentially apply a plurality of small particles in the manner presently claimed, rather than simply bonding a couple of liners 16 to the bottom of a shoe, as Kester actually does, would have produced any offsetting benefit.

In this regard, although the Office Action argues that it would have been obvious to modify Kester in some abstract manner based on a reading of Shin, there is absolutely no indication as to precisely how one of ordinary skill in the art would have modified Kester based on a reading of Shin. Because Kester simply bonds a substrate woven with fibers having one free end, it is believed that it would have been extremely difficult to control where the fibers are placed relative to the protrusions and indentations.

For at least these reasons, independent claim 1 would not have been rendered obvious in view of any permissible combination of Kester and Shin.

Independent claim 30 is directed to a shoe in which a bottom surface that is adjacent to the ground in normal use has a plurality of indentations, with lower extending portions between the indentations. A sole forms at least a portion of the bottom surface, and an upper portion

extends above the sole. A plurality of small particles are bonded differentially to different areas of the bottom surface, with each of a plurality of the lower extending portions being coated more than each of the plurality of indentations.

The foregoing combination of features is not disclosed or suggested by the applied art. For example, no permissible combination of Kester and Shin would have suggested the recited feature that a plurality of small particles are bonded differentially to different areas of the bottom surface of a shoe, with each of a plurality of lower extending portions being coated more than each of a plurality of indentations.

In the Office Action, this feature of claim 30 was asserted as being obvious on precisely the same grounds as discussed above in connection with the rejection of independent claim 1. Accordingly, for similar reasons to those set forth above, claim 30 also is believed to be allowable over the applied art.

The other rejected claims in this application depend from the independent claims discussed above, and are therefore believed to be allowable for at least the same reasons. Because each dependent claim also defines an additional aspect of the invention, however, the individual reconsideration of each on its own merits is respectfully requested.

In order to sufficiently distinguish Applicant's invention from the applied art, the foregoing remarks emphasize several of the differences between the applied art and Applicant's invention. However, no attempt has been made to categorize each novel and unobvious difference. Applicant's invention comprises all of the elements and all of the interrelationships between those elements recited in the claims. It is believed that for each claim the combination of such elements and interrelationships is not disclosed, taught or suggested by the applied art. It

is therefore believed that all claims in the application are fully in condition for allowance, and an indication to that effect is respectfully requested.

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